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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,220

04/28/2005

Shoichi Akita

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9486

28289

7590

09/12/2008

THE WEBB LAW FIRM, P.C.

700 KOPPERS BUILDING

436 SEVENTH AVENUE

PITTSBURGH, PA 15219

EXAMINER

GRABOWSKI, KYLE ROBERT

ART UNIT

PAPER NUMBER

3725

MAIL DATE

DELIVERY MODE

09/12/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/533,220

**Applicant(s)**

AKITA, SHOICHI

**Examiner**

Kyle Grabowski

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-10 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Sterrett et al. (US 3,677,874). Sterrett et al. disclose an insulating laminate comprising an expanded foam layer (foamed polystyrene) 12 heat laminated to a core layer 11, the foamed polystyrene 12 is of a lower density than the core, and hence "expanded" (Col. 27-31) embossed with linear depressions, causing the foamed polystyrene 12 to have partially thinned portions creating an uneven surface portion (Col. 1, 27-36; Fig. 1); the linear depressions are formed by a patterned roll 20 (Col. 2, 44-45; Fig. 2); the heat lamination is preformed with a thermal set adhesive (Col. 1, 64-67).

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Sisson (US 2,917,217). Sisson et al. discloses providing a label made of an expanded foam layer of polystyrene (Col. 1, 15-21) which is embossed by linear protrusions, comprising round bumps in a straight array, (Fig. 6) pressed on an inner side of the label to produce an embossed portion 63 on the outside of the label (no distinction or relevance is given

to the terms "inside" or "outside" only that protrusions on the embossing roll in contact with one side of the film propagate to the opposite side of the film)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sterrett et al. (US 3,677,874) in view of Varano (US 5,226,585). Sterrett et al. substantially disclose the claimed subject matter for the reasons stated above but do not explicitly disclose that the linear depressions have a width of 0.5-3.0 mm. Varano discloses a label 28 having linear depressions 38 which is wrapped around the outer surface of a cup (Fig. 5) wherein the widths of each linear depression 38 is approximately 0.030 inches (0.76 mm) (Col. 4, 37-39). It would have been obvious to one of ordinary skill in

the art at the time the invention was made to provide the linear depressions taught in Sterrett with a width of approximately 0.76 mm in view of Varano to provide a continent gripping surface without detracting from the surface appearance (Varano, Col. 4, 51-55).

Claims 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Sterrett et al. (US 3,677,874) in view of Sarcander (US 4,556,527). Sterrett et al. discloses providing an expanded foam polystyrene laminate 16, which is a "label" as it is applied to a substrate 14 via heat and pressure (Col. 2, 23-25) activating an adhesive layer on its inner side which is provided thereon (Col. 1, 64-65); the outer side of the labels 16 are embossed by pressing plate (embossing roller) 20 which removably contacts the label and which is not supplied with any heat (Fig. 2). Sterrett et al. is silent as to the material comprising the embossing roller however Sarcander discloses that an embossing roller having a rubber surface (a resin, by definition, being any of various products made from a natural resin or a natural polymer) with an embossed pattern for embossing plastic films is known in the art (DE-OS 17-61-403) (Col. 2, 7-10) and it would have been obvious to provide the roller taught in Sterrett et al. with a rubber surface in view of Sarcander to provide the roller with the material advantages provided by rubber. Furthermore it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

### ***Response to Arguments***

Applicant's arguments with respect to claims 9-16 have been considered but are moot in view of the new ground(s) of rejection.

Claims 9-10 and 15, are rejected under 35 U.S.C. 102(b) as being anticipated by Sterrett et al. (US 3,677,874) for the reasons stated above. The cited prior art explicitly discloses an *expanded* foam layer.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sterrett et al. (US 3,677,874) in view of Varano (US 5,226,585) for the reasons stated above.

Claims 12-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Sterrett et al. (US 3,677,874) in view of Sarcander (US 4,556,527) for the reasons stated above. The cited prior art teaches the use of a removably contacting resin plate for the embossing roller.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Sisson (US 2,917,217) for the reasons stated above. The cited prior art discloses an *expanded* foam layer.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hoopingarnier et al. (US 6,251,497), Ragan (US 3,496,043), Mitchell et al. (US 6,224,954), and Barrett (US 5,713,512).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Derris H Banks/  
Supervisory Patent Examiner, Art Unit 3725

/Kyle Grabowski/  
Examiner, Art Unit 3725

